

REMARKS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 2-26 are pending in the Application.

Applicants note that claims 13-19 have not been objected to or rejected by the Examiner in the Office Action. Accordingly, it is respectfully submitted that these claims are in condition for allowance. In the event that claims 13-19 are not allowed, Applicants respectfully submit that the finality of the Office Action must be withdrawn and a new, non-final Office Action must be issued setting a new period for reply. See MPEP §706.07

The drawings were objected to under 37 C.F.R. §1.83(a). The objection is respectfully traversed.

In connection with the objection, the Examiner stated that the drawings do not show a stage with a single side beam. In response, Applicants note that the Examiner is mischaracterizing the invention and submit that the drawings clearly show each and every feature recited by the claims, *i.e.* an apparatus including, *inter alia*, a first side beam and a cross-beam (as opposed to a device including a single side-beam). The Examiner's attention is directed, for example, to FIG. 2, which shows a positioning device including a first side beam 12a and a cross beam 11, to find the required elements. Reference is also made to FIGS. 5 and 8-14, which show a positioning device including a first side beam and a cross beam. Furthermore, as clearly stated in 37 C.F.R. §1.83(a), the test to determine whether the drawings comply with this section is whether the drawings show every feature of the invention specified in the claims. Clearly, the test can be satisfied with drawings that show additional features that are not recited in the claims, as long as these additional features do not correspond to structural details that are essential for a proper understanding of the disclosed invention. (See MPEP 608.02(c)). Accordingly, reconsideration and withdrawal of the objection to the drawings are respectfully requested.

Claims 2-12 and 24-26 were rejected under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed.

In connection with the rejection, the Examiner alleged that the disclosure was not enabling and that the claims contained subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicants note that the "[test] of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (See MPEP 2164.01,

emphasis added). In particular, “[the] test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue.” *Id.* In the present case, one could clearly practice the invention without undue experimentation. The specification describes a positioning device having all of the elements recited by the claims. In addition, the specification teaches one skilled in the art how to connect the different elements, *e.g.* to assemble a first side-beam with a cross-beam and to provide a thrust bearing pivotally mounted to a first slider. It is respectfully submitted that the disclosure, as filed, includes ample embodiments, description and figures that can be used by one skilled in the art to practice the invention without undue experimentation. Accordingly, reconsideration and withdrawal of the rejection of claims 2-12 and 24-26 under 35 U.S.C. §112, first paragraph, are respectfully requested.

Claim 21 was rejected under the statutory type (35 U.S.C. §101) double patenting, based on Kwan *et al.* (U.S. Pat. No. 6,635,887) (“Kwan ‘887”). The rejection is respectfully traversed.

In connection with the rejection, the Examiner alleged that claim 21 claims the same subject matter as that of claim 1 of Kwan ‘887. Applicants disagree and note that claim 1 in Kwan ‘887 does not recite, *inter alia*, a thrust bearing comprising a bearing assembly which acts against a bearing wall of said first-side beam. Therefore, reconsideration and withdrawal of the rejection of claim 21 under the statutory type (35 U.S.C. §101) double patenting, based on Kwan ‘887 are respectfully requested.

Claim 20 was rejected under the judicially created doctrine of obviousness-type double patenting based on claim 1 of Kwan ‘887. Applicants submit herewith a Terminal Disclaimer to overcome the rejection. Accordingly, Applicants respectfully submit that this rejection is moot.

Claims 22-23 were rejected under the judicially created doctrine of obviousness-type double patenting based on claims 2-3 of Kwan ‘887 in view of Novak *et al.* (U.S. Pat. No. 5,623,853) (“Novak”). Applicants submit herewith a Terminal Disclaimer to overcome the rejection. Accordingly, Applicants respectfully submit that this rejection is moot.

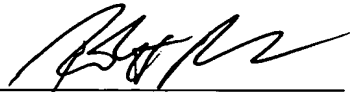
KWAN ET AL. -- 10/648,270
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Applicants have addressed all the Examiner's rejections and respectfully submit that the application is in condition for allowance. A notice to that effect is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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Enclosure: Terminal Disclaimer